

# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 39887/GM/pal	<b>FOR FURTHER ACTION</b>	See item 4 below
International application No. PCT/EP2004/014717	International filing date ( <i>day/month/year</i> ) 27 December 2004 (27.12.2004)	Priority date ( <i>day/month/year</i> ) 30 December 2003 (30.12.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant GEOX S.P.A.		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).
  2. This REPORT consists of a total of 9 sheets, including this cover sheet.
- In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

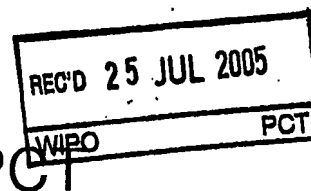
- |                                     |              |   |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I    | Basis of the report   |
| <input type="checkbox"/>            | Box No. II   | Priority  |
| <input checked="" type="checkbox"/> | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input checked="" type="checkbox"/> | Box No. IV   | Lack of unity of invention  |
| <input checked="" type="checkbox"/> | Box No. V    | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input checked="" type="checkbox"/> | Box No. VI   | Certain documents cited.  |
| <input type="checkbox"/>            | Box No. VII  | Certain defects in the international application  |
| <input type="checkbox"/>            | Box No. VIII | Certain observations on the international application   |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 03 July 2006 (03.07.2006)
Facsimile No. +41 22 338 82 70	Authorized officer <div style="text-align: right; font-weight: bold;">Ellen Moyse</div> e-mail: pt05@wipo.int

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY



To:

see form PCT/ISA/220

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference see form PCT/ISA/220		<b>FOR FURTHER ACTION</b> See paragraph 2 below	
International application No. PCT/EP2004/014717	International filing date (day/month/year) 27.12.2004	Priority date (day/month/year) 30.12.2003	
International Patent Classification (IPC) or both national classification and IPC A43B7/06, A43B7/12, A43B13/12, B05D7/24			
Applicant GEOX SPA			

### 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☒ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☒ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application



### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

### 3. For further details, see notes to Form PCT/ISA/220.

<p>Name and mailing address of the ISA:</p>  <p>European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465</p>	<p>Authorized Officer</p> <p>Vesin, S</p> <p>Telephone No. +49 89 2399-7489</p> 
---	---

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2004/014717

---

**Box No. I Basis of the opinion**

---

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
  - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material:
    - ☐ a sequence listing
    - ☐ table(s) related to the sequence listing
  - b. format of material:
    - ☐ in written format
    - ☐ in computer readable form
  - c. time of filing/furnishing:
    - ☐ contained in the international application as filed.
    - ☐ filed together with the international application in computer readable form.
    - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2004/014717

**Box No. III Non-establishment of opinion with regard to novelty, inventive step and Industrial  
applicability**

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,
- ☒ claims Nos. 25-30

because:

- ☐ the said international application, or the said claims Nos. . . . relate to the following subject matter which does not require an international preliminary examination (*specify*):
- ☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. . . . are so unclear that no meaningful opinion could be formed (*specify*):
- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☒ no international search report has been established for the whole application or for said claims Nos. 25-30
- ☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:
  - the written form ☐ has not been furnished
  - ☐ does not comply with the standard
  - the computer readable form ☐ has not been furnished
  - ☐ does not comply with the standard
- ☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.
- ☐ See separate sheet for further details

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2004/014717

---

**Box No. IV Lack of unity of invention**

---

1. ☒ In response to the invitation (Form PCT/ISA/206) to pay additional fees, the applicant has:
- ☐ paid additional fees.
  - ☐ paid additional fees under protest.
  - ☒ not paid additional fees.
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
- ☐ complied with
  - ☒ not complied with for the following reasons:  
**see separate sheet**
4. Consequently, this report has been established in respect of the following parts of the international application:
- ☐ all parts.
  - ☒ the parts relating to claims Nos. 1-24,26

---

**Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

---

1. Statement

Novelty (N)	Yes: Claims	4
	No: Claims	1-3,5-11,26
Inventive step (IS)	Yes: Claims	
	No: Claims	4,12-24
Industrial applicability (IA)	Yes: Claims	1-24,26
	No: Claims	

2. Citations and explanations

**see separate sheet**

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2004/014717

---

**Box No. VI Certain documents cited**

---

1. Certain published documents (Rules 43*bis*.1 and 70.10)  
and /or
2. Non-written disclosures (Rules 43*bis*.1 and 70.9)  
**see form 210**

**Re Item IV.**

This International Searching Authority found multiple (groups of) inventions in this international application, as follows:

- 1) Claims 1-24,26: A waterproof breathable sole with a coating obtained by plasma deposition
- 2) Claims 25,26: A breathable and waterproof sole with hermetically joined sole elements around their perimeter
- 3) Claims 27-3: A waterproof and breathable shoe with sealing area between upper and membrane

They are not so linked as to form a single general inventive concept (Rule 13.1 PCT) for the following reasons:

The definitions of the different (groups of) claimed inventions are only intended to identify said inventions in a concise manner. They may well, as such, comprise terms or generalisations which upon a close analysis could be found to extend the defined subject matter beyond the contents of the applications as filed.

Document **US 6 508 015 (D1)** discloses a waterproof breathable sole for shoes with a microporous layer and a supporting structure

The special technical features, as defined in Rule 13.2 PCT, of the first group of claims, which are intended to be a contribution over this prior art, i.e. adding a coating by plasma deposition, apparently solves the problem of improving the hydrophobic function of the microporous layer.

The special technical features, as defined in Rule 13.2 PCT, of the second group of claims, which are intended to be a contribution over said prior art, i.e. the features of hermetically joining the sole elements around their perimeter, apparently solve the problem of water infiltration around the perimeter.

The special technical features, as defined in Rule 13.2 PCT, of the third group of claims,

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING  
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/EP2004/014717

which are intended to be a contribution over said prior art, i.e. sealing the area between upper and membrane, apparently solves the problem of waterproofness between upper and membrane.

No same or similar special technical features can be determined and different underlying problems are solved. Moreover, it is clear that the 3 claimed inventions can be applied independently of each other, i.e they are not necessarily inter-related.

It appears therefore that no technical relationship between the various claimed inventions exists involving one or more of the same or corresponding special technical features, beside the common and already well known feature of providing a breathable sole, see document US 6 508 015. The 3 groups of claims are thus not so linked as to form a single general inventive concept.

Furthermore, searching more than one of these different subjects would have caused major additional search efforts.

Before following the invitation to pay additional search fees the applicant is advised to carefully consider his intentions in later stages of the procedure (i.e. Chapter II). Applicant should take into account that additional search fees, once paid, are unlikely to be refunded if at such a later stage it becomes in retrospect apparent that in the light of amendments of the claims such a payment was in fact unnecessary.

Such a case may rise where the applicant in that later stage of the proceedings arrives at a subject-matter to be protected which includes the further subjects here identified only in dependency on the subject identified here as the main (first) invention.

**Re Item V.**

Reference is made to the following documents:

D1 : US 6 508 015 B1

D2 : EP 0 275 644 A

D3: EP-A-0 985 741



**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING  
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/EP2004/014717

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT.

Document D1 discloses all the features of claim 1 and especially it shows a coating 8 (cf. figure 6; col.5, lines 9-17) located on the top of the microporous layer 1.

N.B. the claimed sole is defined by a process of making the coating, which appears to be inherently the same coating as the one of D1 even if D1 does not disclose the process (see PCT guidelines page 43, 5.26) of obtaining said coating.

The subject-matter of claim 1 is also known from document D2 (see corresponding passages of the search report)

Dependent claims 2, 3, 5-15, 18, 19, 21, 23 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step (Article 33(2) and (3) PCT).

Especially the general concept of plasma deposition for coating substrates in order to render said them waterproof as well as all the parameters defined in the claims for performing the plasma deposition are known from **D3** (see [0006], [0012]-[0016], [0019]-[0020])